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09/773,238	01/31/2001	Peter Dodt	GZI-10002/22	6137

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT PAPER NUMBER

3623

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,238

Applicant(s)

DODT ET AL.

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to:
 - a. as failing to comply with 37 CFR 1.84(l) because every line is not sufficiently dense and dark, and uniformly thick and well-defined.
 - b. as failing to comply with 37 CFR 1.84(m) because
 - i. the solid black shading areas (Fig.1 and Fig.5) are not permitted; and,
 - ii. the dark gray shading used at element 118 (Fig.5) does not aid in understanding the invention and should be omitted.
 - c. as failing to comply with 37 CFR 1.84(p)(4) because
 - i. reference characters “8” (Fig.4), “38” (Fig.3), “78” (P.8, L.11), and “128” (Fig.5) have all been used to designate customer information database;
 - ii. reference characters “10” (Fig.1) and “126” (Fig.5) have both been used to designate work order component;
 - iii. reference characters “12” (Fig.1) and “134” (Fig.5) have both been used to designate outsourcing component;
 - iv. reference characters “14” (Fig.1) and “126” (Fig.5) have both been used to designate customers; moreover, reference character “126” (Fig.5) has been used to designate both customers and work order component;
 - v. reference characters “18” (Fig.1) and “136” (Fig.5) have both been used to designate service providers;

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- vi. reference character “20” has been used to designate both receive work order request from customer (Fig.1) and new customer sign-up (Fig.2);
 - vii. reference characters “28” (Fig.4 and P.7, L.10) and “72” (Fig.4 and P.8, L.11) have both been used to designate new customers;
 - viii. reference characters “32” (Fig.3) and “74” (Fig.4 and P.8, L.12) have both been used to designate the review, edit, print information step;
 - ix. reference characters “43” (Fig. 3) and “76” (Fig.4 and P.8, L.12) have both been used to designate submit;
 - x. reference characters “88” (Fig.4), “100” (Fig.4), and “130” (Fig.5) have all been used to designate basic job details;
 - xi. reference characters “108” (Fig.4) and “116” (Fig.4) have both been used to designate basic job details customer info databases; and,
 - xii. reference characters “112” (Fig. 4) and “132” (Fig.5) have both been used to designate administration database.
- d. as failing to comply with 37 CFR 1.84(q) because
- i. the lead lines in each drawing figure are not sufficiently dense and dark, and uniformly thick and well-defined;
 - ii. in Fig.1, the use of bracketing, rather than lead lines, for reference characters 14 and 16 is improper;
 - iii. in Fig.1 and Fig.5, lead lines are required for each reference character except for those which indicate the surface or cross section on which they are

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placed, such a reference character must be underlined to make it clear that a lead line has not been left out by mistake.;

iv. in Fig.3, the line connecting elements 58 and 60 at the lower left quadrant, appears to be missing an arrowed end;

v. in Fig.4, there are lead lines that lack a reference character at the left margin of the drawing sheet; and,

vi. in Fig.5, the use of bracketing, rather than lead lines, for reference characters 126 and 136 is improper.

e. as failing to comply with 37 CFR 1.84(u)(1) because

i. Figure 3 is comprised of two separate figures that must be labeled separately, i.e., identified by the same view number followed by a capital letter; and,

ii. Figure 4 is comprised of three separate figures that must be labeled separately, i.e., identified by the same view number followed by a capital letter.

f. as failing to comply with 37 CFR 1.84(u)(2) because the view numbers must be larger than the reference characters.

Applicant should review the specification and drawings to ensure compliance with 37 CFR 1.84. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be

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removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities (in addition to the inconsistencies noted in the above drawing objections):

- a. reference character "72" (P.8, L.11) is not consistent with reference character "2" depicted in Fig.4.
- b. reference character "78" (P.8, L.13) is not consistent with reference character "8" depicted in Fig.4;
- c. reference character "106" (P.9, L.12) is inconsistent with reference character "108" depicted in Fig.4; and,
- d. reference character "120" (Fig.5) is not included in the specification.

Applicant should review the specification and drawings to ensure compliance with 37 CFR 1.84.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble recitation of claim 5 is not wholly consistent with the body of the claim. The preamble recites a system, which infers that the body of the claim is directed to structure or an apparatus; and, the preamble concludes with “comprising the steps of” which infers that a process or method steps will follow. Further, the body of each claim is directed to method steps including the “-ing” verb suffix. Claims 5-12 are not clear as to the metes and bounds of patent protection desired.

For purposes of this Office action, Claims 5-12 have been treated as process claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

As to the first prong, for a claimed invention to be statutory the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature,

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natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to the second prong, for a claimed invention to be statutory the claimed invention must produce a useful, concrete, and tangible result.

Claims 1-4

As to the first prong, even though a practical application of completing a work order is recited in process claims 1-4, the claimed process lacks a tie to any technological art. The process claims do not recite any limitations that involve a technology, and the claimed process steps do not require use of any technology to implement the invention. The claims recite an abstract idea for receiving and processing a work order and not any technology, e.g., computer hardware or hardware with software elements. For example, claim 1 recites the steps of receiving a work order, transferring the work order, engaging a service provider, and completing the work order. The recited steps are an abstract idea for fulfilling a work order and they lack positive recitation of any technology, e.g., computer hardware or hardware with software elements, to perform the steps.

Further, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. The claimed process must utilize technology in a non-trivial manner. In the present case, even though the process of claims 1-4

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applies, involves, or uses technology by transferring the information over a communications network, it is a nominal use of computer-related technology and falls short of non-trivial utilization of technology.

In the present case, the claimed invention merely recites electronic activity and does not produce a useful, concrete, and tangible result.

In conclusion, process claims 1-4 do not meet the second prong of the two-prong test because they do not produce a useful, concrete, and tangible result, moreover, they do not meet the first prong because they are not within a technological art, as explained above. Therefore, process claims 1-4 are deemed to be directed to non-statutory subject matter.

Claims 5-12

As to the first prong, even though a practical application of a service provider processing at least a portion of a work order is recited in process claims 5-12, the claimed process lacks a tie to any technological art. The process claims do not recite any limitations that involve a technology, and the claimed process steps do not require use of any technology to implement the invention. For example, claim 5 recites the steps of providing a selection of printers, receiving a designation for a printer, providing an interface screen, receiving a work order request, providing a portion of data, and processing the work order. The recited steps are an abstract idea for receiving and processing a work order and they lack positive recitation of any technology, e.g., computer hardware or hardware with software elements, to perform the steps.

Further, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. The claimed process must utilize

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technology in a non-trivial manner. In the present case, even though the process of claims 5-12 applies, involves, or uses technology by the preamble recitation of receiving work orders “via a communications network” it is a nominal use of computer-related technology and falls short of non-trivial utilization of technology.

In the present case, the claimed invention merely recites electronic activity and does not produce a useful, concrete, and tangible result.

In conclusion, process claims 5-12 do not meet the second prong of the two-prong test because they do not produce a useful, concrete, and tangible result, moreover, they do not meet the first prong because they are not within a technological art, as explained above. Therefore, process claims 5-12 are deemed to be directed to non-statutory subject matter.

Claims 13-20

As to the first prong, even though a practical application of receiving and processing work order requests is recited in process claims 13-20, the claimed process lacks a tie to any technological art. The process claims do not recite any limitations that involve a technology, and the claimed process steps do not require use of any technology to implement the invention. The claims recite an abstract idea for receiving and processing a work order and not any technology, e.g., hardware or hardware with software elements. For example, claim 13 recites a system comprising a work order component, a storage component, and an outsourcing component. Each component is disclosed in the specification (P.4, L.18 to P.5, L.9) as software.

Further, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. The claimed process must utilize

technology in a non-trivial manner. In the present case, even though the process of claims 13-20 applies, involves, or uses technology by the preamble recitation of receiving work orders “via a communications network”, it is a nominal use of computer-related technology and falls short of non-trivial utilization of technology.

In the present case, the claimed invention merely recites nonfunctional descriptive material, i.e., software *per se*, and does not produce a useful, concrete, and tangible result.

In conclusion, process claims 13-20 do not meet the second prong of the two-prong test because they do not produce a useful, concrete, and tangible result, moreover, they do not meet the first prong because they are not within a technological art, as explained above. Therefore, process claims 13-20 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-8, 10-19 are rejected under 35 U.S.C. 102(b) as being anticipated by

Huberman (US-5826244).

The method of seamless use of a service provider (supplier in the second auction of the multiple auction embodiment) by a printer (supplier in the first auction and customer in the second auction of the multiple auction embodiment) is discussed at C.8, L. 43-65 and at C.18.,L.51 to C.19, L.13.

Regarding claims 1, 3-7, and 13-16, Huberman discloses a method of fulfilling a work order for a print job request or document service including the steps of receiving a work order (printing request), transferring the work order to the printing facility (supplier) via a network (100), engaging an outside service provider (supplier in a multiple auction), and completing the work order (by the supplier in the first auction supplying the document service specified in the printing request of the customer in the first auction). The network (100) as disclosed in Huberman includes an interface component (104) with the Internet (C.5, L.59-65).

Regarding claims 8, and 17-19, it is inherent in Huberman that the customer, administration, and job detail information is stored because the broker provides information about the customer and the work order to the supplier upon conclusion of an auction having a winning bid (see Fig.3 and Fig.4).

Regarding claims 10 and 11, the Huberman work order (printing request) includes a file and customer information associated with the work order (see C.8, L.24-33 which discusses software associated with the customer process). It is inherent in Huberman that files (and data) associated with the work order, including files, would be converted using software.

Regarding claim 12, Huberman discloses the supplier or printer providing a quotation via the broker to the customer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman (US-5826244) in view of Klasnic (article, Head-to-head on outsourcing) and Salvetti (article, Is outsourcing right for you).

Notwithstanding Klasnic's discussion of a business, other than a commercial printer, providing in-plant printing versus outsourcing, Klasnic teaches that a commercial printer will contract or outsource prepress service (see P.28, C.1, L.7-8).

Salvetti suggests numerous benefits of outsourcing including expertise, efficiency, and objectivity.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Huberman to include prepress service as the second auction in the multiple auction embodiment, such as taught by Klasnic and Salvetti, in order to gain expertise, efficiency, and objectivity.

7. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman (US-5826244) in view of Sevcik (US-6330542).

Sevcik teaches a login for an automated Internet quoting system in order to ensure that the customer is registered and have an account.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Huberman to include a login, such as taught by Sevcik, in order to ensure that the customer using the system is registered and has an account.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Craig, Stuart, and Worona disclose outsourcing of printing services.
- Langhans and Sparks disclose Internet purchasing systems.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918.

The examiner can normally be reached on Monday - Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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